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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/518,926

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Makoto Ishikawa

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EXAMINER

KUGEL, TIMOTHY J

ART UNIT

PAPER NUMBER

1796

NOTIFICATION DATE

DELIVERY MODE

08/19/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

Office Action Summary	Application No. 10/518,926	Applicant(s) ISHIKAWA ET AL.	
	Examiner Timothy J. Kugel	Art Unit 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 July 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>07/09/2009</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-4 are pending as amended on 9 July 2009, claims 5-10 being cancelled.
2. A request for continued examination under 37 CFR 1.114 was filed in this application after appeal to the Board of Patent Appeals and Interferences, but prior to a decision on the appeal. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on 9 July 2009 has been entered.
3. The text of those sections of Title 35, US Code not included in this action can be found in a prior Office action.

Response to Amendment and Arguments

4. Applicant's arguments have been fully considered, but are not persuasive.
Applicant argues that the listing of potential emulsifiers in International Patent Application Publication WO 01/58279 (Takahashi), including those of the instant invention and those of US Patent 6,193,986 (Sakurada) does not show functional equivalence as Takahashi's teaching is limited to the technology of Takahashi and not that of the instant invention; however, it is the examiner's position that no such limitation

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in technology is established in Takahashi and one of ordinary skill in the art at the time the invention was made would have understood the teaching of Takahashi to be that the emulsifiers were functionally equivalent in emulsifying regardless of the technology used.

Applicant further argues that the declaration under 37 CFR 1.132 of Makoto Ishikawa filed 9 July 2009, clarifying the declaration under 37 CFR 1.132 of Makoto Ishikawa filed 10 July 2008 establishes unexpected beneficial results over Sakurada; however, while clarifying the qualifications of the testers in question and providing the raw data of the taste and odor testing, it is still the position of the examiner that such results are not commensurate in scope with the claims since only a single point rather than the claimed range of sucrose acetate isobutyrate was tested and—the amendment of the claims to require the presence of fish oil notwithstanding—still contains the unclaimed glycerol; and are still subjective rather than objective evidence of unexpected results. Further, and more pertinent, JP07-115901 (Kazuyoshi), cited by applicant on the information disclosure statement filed 9 July 2009, anticipates applicant's claims and further shows that compositions containing sucrose acetate isobutyrate have no fishy smells from docosahexaenoic acid has been known in the art since 1993 and therefore such cannot have been unexpected.

Information Disclosure Statement

5. The information disclosure statement submitted on 9 July 2009 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the examiner has considered the information disclosure statement.

It is noted that applicant has included what appears to be an office action from the JPO in the file, but it does not appear on an Information Disclosure Statement and further is not in English and fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information. It has been placed in the application file, but the information referred to therein has not been considered.

Claim Rejections - 35 USC § 102

6. **Claims 1-4** are rejected under 35 USC 102(b) as being anticipated by JP 07-115901 (Kazuyoshi). Please note that the citations appearing in this rejection are taken from the machine translation of Kazuyoshi included with this action.

Kazuyoshi teaches an emulsified composition comprising an oil and fat rich in docosahexaenoic acid, a polyglycerol fatty acid ester, and sucrose diacetate hexaisobutyrate and its use in a health drink (Abstract), and further that the docosahexaenoic acid is present in fish oil with eicosapentaenoic acid (0002) and the sucrose diacetate hexaisobutyrate is present as 0.2 to 0.8 weight percent preferably from 0.4 to 0.6 weight percent (0014).

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Since Kazuyoshi teaches the use of such composition in fruit juice (Abstract), which is aqueous, it is taken that the emulsion is oil-in-water.

The following is a quotation of the appropriate paragraph of 35 USC 102 that form the basis for the following rejection under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. **Claims 1-4** are rejected under 35 USC 102(e) as being anticipated by US Patent Application Publication 20030021878 (Nunes).

8. Nunes teaches food and beverage compositions (Abstract) comprising oil-in-water emulsions (0004) which comprise fish oil for its omeg-3-fatty acids (0005 and 0006)—specifically exemplifying arachidonic, docosahexaenoic and eicosapentaenoic acids as such (0039 and 0040)—fatty acid esters of glycerol (0029-0035) and a clouding agent—specifically exemplifying 0 to 25% sucrose acetate isobutyrate (0078 and 0079).

Claim Rejections - 35 USC § 103

9. **Claims 1-4** stand rejected under 35 USC § 103(a) as being unpatentable over US Patent 6,193,986 (Sakurada hereinafter) in view of US Patent 4,379,755 (Yamada hereinafter) and in further view of International Patent Application Publication WO

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01/58279 (Takahashi hereinafter) as evidenced by Kazuyoshi. US Patent Application Publication 2003/0035859 is the US equivalent to Takahashi and all references herein are taken therefrom.

Sakurada teaches a foodstuff (Column 1 Lines 5-13) comprising an water-in-oil emulsion (Column 1 Lines 14-33) wherein the oily phase comprises 0.5 to 50% of an emulsifier (Column 6 Lines 16-18) including hexaglycerol trioleate—a polyglycerol fatty acid ester—and sucrose fatty acid esters as exemplified in the instant specification alone or in combination (Column 4 Line 53 – Column 5 Line 31) and an oily component, including arachidonic acid, eicosapentaenoic acid and docosahexaenoic acid (Column 5 Line 47 – Column 5 Line 15)—both polyvalent unsaturated fatty acids. Kazuyoshi shows that eicosapentaenoic acid and docosahexaenoic acid come from fish oil (0002).

Sakurada does not disclose expressly such a composition in an oil-in-water composition.

Yamada discloses an emulsion for use in cosmetics or food wherein the emulsion is of the oil-in-water type comprising a sucrose fatty-acid ester emulsifier (Column 1 Lines 16-60).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to produce the Sakurada foodstuff as an oil-in-water emulsion as taught by Yamada. The rationale to do so would have been the motivation provided by the teaching of Yamada that such emulsions are much desired over water-in-oil types as they have superior feel and homogeneity (Yamada Column 1 Lines 37-43 and 67-60).

Neither Sakurada nor Yamada disclose expressly the use of sucrose acetate butyrate as an emulsifying agent.

Takahashi discloses that sucrose acetate isobutyrate is an equivalent emulsifying agent to the sucrose fatty acid esters taught by Sakurada and Yamada (Takahashi 0029).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to include the sucrose acetate isobutyrate emulsifying agent of Takahashi in the composition of Sakurada. The rationale to do so would have been the motivation provided by the teaching of Takahashi that sucrose acetate isobutyrate is a functional equivalent to sucrose fatty acid esters and further, since it has been held that it is *prima facie* obviousness to use a known material based on its suitability for its intended use. See MPEP 2144.06(II) and 2144.07; *In re Fout*, 675 F2d 297, 213 USPQ 532 (CCPA 1982); *Sinclair & Carroll Co v Interchemical Corp*, 325 US 327, 65 USPQ 297 (1945); *In re Leshin*, 227 F2d 197, 125 USPQ 416 (CCPA 1960) and *Ryco, Inc v Ag-Bag Corp*, 857 F2d 1418, 8 USPQ2d 1323 (Fed Cir 1988).

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Timothy J. Kugel whose telephone number is 571-272-1460. The examiner can normally be reached on 6:30 AM - 5:00 PM Monday - Thursday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

11. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Timothy J. Kugel/
Primary Examiner, Art Unit 1796